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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/786,903	05/09/2001	Jens Stefan Schneider	10191/1714	7920
26646	7590	02/09/2004	EXAMINER	
KENYON & KENYON ONE BROADWAY NEW YORK, NY 10004			OLSEN, KAJ K	
			ART UNIT	PAPER NUMBER
			1753	
DATE MAILED: 02/09/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/786,903

Applicant(s)

SCHNEIDER ET AL.

Examiner

Kaj Olsen

Art Unit

1753

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 10-29 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

3. Claims 10-19 stand rejected for lack of enablement as set forth in the previous office action. Applicant has amended the claims to state that the cermet includes both a metallic component and a ceramic component. This new limitation does address some of the confusion concerning what the applicant's use of "cermet" referred to. In addition, this examiner will concede that this new limitation does *not* introduce new matter because a reasonable reading of applicant's term "cermet" would be the now specified combination of a metallic and ceramic components. However, although applicant's limitation clarifies some questions, it also introduces new questions of enablement. In particular, the claim now specifies that the first measuring electrode is a combination of metal oxide, ceramic and metal components. With respect to the ceramic, there does not appear to be any recitation of what kind of ceramic would be utilized for the electrode. With respect to the metal, there doesn't appear to be any recitation drawn to what the choice of metal would be. The only thing the examiner can reasonably infer from the application is that the metallic component in question would not be Pt, Sb, Pb, Pd or Rh

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in view of page 3, lines 13-27 and page 8, lines 10-14 of the specification. Furthermore, the metallic component would also not be Au or Ag in view of page 8, lines 25-29 of the specification and claim 13 which specifies that the electrode would only *further* comprise these metals. It would appear that one possessing ordinary skill in the art would only know what metal not to utilize and would have no guidance on what metals to utilize for the metallic component. Hence it would appear that the novelty of the invention resides at least in part on a new combination of metal oxide, ceramic, and metal, but applicant has neglected to specify (either generally or specifically) what the ceramic or metal would be. One possessing ordinary skill in the art could not reasonably construct the claimed and described sensor without undue experimentation.

4. Claims 20-29 are new claims that depend from claim 10 and are similarly found to lack enablement because of their dependence from claim 10.
5. Claims 20-22, 26 and 28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.
6. Claim 20 depends from claim 12 and specifies the use of a particular mixed oxide in addition to the metal oxide specified in claim 12. The examiner cannot find any support for the *combination* of any of the materials of claim 12 with any of the materials of claim 20. Page 8, lines 22-24 appear to state that one could use the materials of claim 20 or the materials of claim 12. There is nothing to suggest that these materials would be utilized in combination.

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Response to Arguments

7. Applicant's arguments of 11-10-2003 were largely persuasive. In particular, the arguments concerning the art rejections over Koehler and Kurosawa were persuasive. The examiner is also withdrawing the outstanding 112 second paragraph rejections in view of both the amendment and arguments. However, other than clarifying by amendment what the "cermet" of claim 10 referred, applicant has not clarified what the particular ceramic and metal component of claim 10 is referring to (see discussion above).

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kaj Olsen whose telephone number is (571) 272-1344. The examiner can normally be reached on Monday through Thursday from 7:00 AM-4:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Nam Nguyen, can be reached at (571) 272-1342.

When filing a fax in Group 1700, please indicate in the header "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of this application. This will expedite processing of your papers. The fax number for all official communications is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (571) 272-1300.

A handwritten signature in black ink, appearing to read 'Kaj Olsen', with a long horizontal flourish extending to the right.

Kaj K. Olsen
Primary Examiner
AU 1753
February 2, 2004